

O/292/12

TRADE MARKS ACT 1994

**CONSOLIDATED PROCEEDINGS IN THE MATTER OF APPLICATIONS
2549556 AND 2571008
BY INVACARE INTERNATIONAL SARL
FOR RESPECTIVE APPLICATIONS OF THE TRADE MARK:**

SOFT-AIR

AND

**RESPECTIVE OPPOSITIONS THERETO (NOS 101059 AND 101802)
BY MEDISEARCH PR, INC**

The background and the pleadings

1) Application 2549556 was filed by Invacare International Sarl ("the Applicant") on 4 June 2010 in respect of the following mark:

SOFT-AIR

2) The mark was published in the Trade Marks Journal on 2 July 2010. Registration is sought in respect of the following goods:

Class 10: Surgical and medical apparatus and instruments; artificial limbs, eyes and teeth; orthopaedic articles; suture materials; respiratory apparatus; oxygen concentrators, apparatus for the distribution and storing of liquid oxygen, aerosol therapy apparatus, respiratory apparatus for sleep therapy; apparatus for ventilation of the lungs; supporting apparatus, lifting apparatus, transfer apparatus, hoists, slings and spreaders, all for the physically handicapped, those of reduced mobility and invalids; lifting apparatus and transfer apparatus for the bath, the bed and the toilet for the physically handicapped, those of reduced mobility and invalids; security jackets, harnesses and belts for the physically handicapped, those of reduced mobility and invalids; beds for medical purposes; waterbeds for medical purposes; airbeds for medical purposes; adjustable backrests for beds for medical purposes; bed lifters, bed rails, all for the physically handicapped, those of reduced mobility and invalids; bedclothes frames for the physically handicapped; corsetry for medical purposes; mattresses for medical purposes; foam mattresses for medical purposes; cushions for medical purposes, cushions for prevention of bed sores and positioning cushions for the physically handicapped, those of reduced mobility and invalids; walking aids; crutches, walking frames, rollators; reach extension devices, applicators for socks, stockings and panty hose, all for use by the physically handicapped, those of reduced mobility and invalids; shower stretchers for the physically handicapped, those of reduced mobility and invalids; rehabilitation, training and play equipment for the physically handicapped, those of reduced mobility and invalids; rehabilitation, training and play equipment in the form of elastic seating, elastic chairs, elastic ramps, elastic rollers and elastic tunnels for the physically handicapped, those of reduced mobility and invalids; parts and fittings for all of the aforementioned goods.

Class 12: Vehicles for the physically handicapped and those of reduced mobility; wheelchairs, push wheelchairs, manually propelled wheelchairs, sporting wheelchairs, leisure wheelchairs, powered wheelchairs; electrical propulsion units for wheelchairs; electrical driving equipment for manually propelled wheelchairs; electric motors for vehicles; scooters; powered tricycles and quadricycles for the physically handicapped and those of reduced mobility; shower trolleys for use by the physically handicapped

and those of reduced mobility; seating platform for power wheelchairs, in particular for power wheelchairs, fittings and parts for all of the aforementioned goods.

Class 20: Furniture; seating, backrests, cushions; furniture for the physically handicapped, those of reduced mobility and invalids; beds and accessories for beds, home care beds, institutional beds, hospital beds; hangers, bed rails, bed tables, baskets, baskets for supporting medical apparatus; mattresses; foam mattresses; airbeds and waterbeds; bath seats, shower seats and toilet supports; hand rails and bars for toilets, bathrooms, baths and showers; lift-out chairs; work seats for the physically handicapped and those of reduced mobility; fittings and parts for all of the aforementioned goods

3) On 4 October 2010 Medisearch PR, Inc (“the Opponent”) filed a notice of opposition in respect of all of the above goods. Its opposition is based on a ground under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). A single earlier mark is relied upon, namely UK trade mark 1349473 (“the Opponent’s Mark”); it is shown below, together with the goods in respect of which it is registered:

SOF.CARE

Class 10: Surgical, medical and therapy apparatus and instruments; upholstery for surgical, medical and therapeutic purposes; contoured and inflated cushions for patients’ use on beds and chairs; parts and fittings for all the aforesaid goods; all included in Class 10.

4) The Opponent’s mark was filed on 28 June 1988, and completed its registration procedure on 2 March 1990. The consequences of these dates are that: i) the Opponent’s Mark constitutes an earlier mark in accordance with section 6 of the Act, and ii) it is subject to the proof of use conditions contained in section 6A of the Act, the registration procedure being completed more than five years before the publication of the Applicant’s mark. The relevant period during which genuine use must be proved is 3 July 2005 to 2 July 2010.

5) On 2 February 2011 the Applicant filed a counterstatement denying that the mark applied for is similar to the Opponent’s Mark and asserting that few of the goods of the Opponent’s mark are identical with those in the application, and that there was no likelihood of confusion. The Applicant asked the Opponent to provide proof of use of the Opponent’s Mark.

6) Also on 2 February the Applicant filed a further trade mark application, no. 2571008. The mark applied for and the goods in respect of which registration is sought are identical with those of its earlier application no. 2549556, as shown above. The mark was published in the Trade Mark Journal on 18 February 2011.

On 15 April 2011 the Opponent filed a notice of opposition in similar terms to its notice of opposition in the first proceedings, again relying on the Opponent's Mark. On 20 June 2011 the Applicant filed a counterstatement in slightly expanded but similar terms to its counterstatement in the first proceedings. It again asked for use of the Opponent's Mark to be proved, the relevant period during which use must be proved for the second proceedings being 19 February 2006 to 18 February 2011. The mark in the two applications will be referred to below as the "Applicant's Mark".

7) Following the filing of the counterstatement in the second opposition proceedings the two opposition proceedings were consolidated. The Opponent filed evidence and written submissions. The Applicant filed only written submissions. Neither side requested a hearing. I therefore give this decision after a careful review of all the papers before me.

The Opponent's evidence and the Applicant's submissions

First Witness Statement of Gillian Smaggasgale

8) Ms Smaggasgale, a partner in the firm of W.P. Thompson & Co., which represents the Opponent in these proceedings, filed a witness statement of 26 September 2011 ("First Witness Statement") on behalf of the Opponent. She states that her evidence comes from either her own knowledge or from information supplied to her by the Opponent. She does not differentiate in her evidence between the two sources. The relevance of this is that evidence based upon information supplied by the Opponent is potentially hearsay. However, as much of the evidence she gives (in her first witness statements and in the others I will come on to) is in the form of various documents this may not be too significant.

9) Ms Smaggasgale explains that the Opponent was a division of Gaymar Holding Inc. and a sister company of Gaymar Industries Inc, both of which have now been acquired by an entity called Stryker (the full name of this acquiring enterprise and the date of acquisition are not given). Ms Smaggasgale states that availability of information prior to the acquisition by Stryker is limited. It is stated that products produced by Gaymar (she does not say which Gaymar company) and the Opponent were available through their UK distributor, Scan Mobility Ltd; no particular products or trade marks are identified at this stage. Ms Smaggasgale does, however, provide an archive website print sourced from the Internet archive website "waybackmachine" in respect of the website www.scanmobility.co.uk/sofcare (**Exhibit GHS1**). It is dated 17 November 2009 (within the relevant proof of use periods). It is headed "Sof.Care Accessories" and it contains a link (headed "Pressure Relieving Air Accessories") from which a product brochure is downloaded. The brochure contains the trade marks SCAN MOBILITY, GAYMAR and SOF.CARE. The brochure depicts a number of what are described as pressure relieving air accessories including: a theatre pad (what

appears to be an inflatable mattress for use in a medical theatre to support the patient), heel boot (this appears to be an inflatable device which wraps around the lower leg and is said to assist with ulcer prevention), heel pad (which is placed under the calf and heel to relieve pressure) and a seat cushion (an inflatable cushion used on a chair for “acute, long-term and home care environments”).

10) **Exhibit GHS2** contains two purchase orders from July and August 2011 from two separate NHS Trusts in relation to the boot product. However, this is after the proof of use periods; the supplier on both is Stryker. I note that the products are identified as SOFTCARE (not SOF.CARE) products on both orders, a point I will come back to later.

Second Witness Statement of Gillian Smaggasgale

11) In a further statement of 10 October 2011 (“Second Witness Statement”) Ms Smaggasgale attaches as **Exhibit GHS3** seven invoices, five of which fall within the relevant proof of use periods, the other two pre-dating them. Of the five that fall within the relevant periods, all are made out in US dollars, from Gaymar (which one is not clear) to Scan Mobility Ltd and refer to products by the codes listed in Scan Mobility Ltd’s online brochure in **Exhibit GHS1** as follows:

Date	Qty	Item	Description	Unit Price	Amount
19/05/10	102	HCB2001	Air Heelcare Boot	25.10	2,560.20
14/10/09	60	HCB2001	Air Heelcare Boot	25.10	1,506.00
28/05/09	60	HCB2001	Air Heelcare Boot	25.10	1,506.00
28/05/09	100	HC200CE	Heelcare Cushion	12.80	1,280.00
17/04/07	42	HCB2001	Air Heelcare Boot	24.15	1,014.30

Ms Smaggasgale states that the Air Heelcare Boot identified in the invoices is sold under the Opponent’s Mark. This is supported by the online brochure in Exhibit **GHS1** (which also uses the mark in relation to the product identified with the code HC200CE (the Heelcare Cushion)).

Applicant’s Submissions in Reply

12) Bailey Walsh & Co LLP, who represent the Applicant in these proceedings, filed written submissions of 28 December 2011 in response to Ms Smaggasgale’s evidence. They submit that no evidence has been provided that the purported use of the Earlier Mark in the UK had been authorized by the Opponent, other than Ms Smaggasgale’s belief that Scan Mobility were distributors of Gaymar’s and the Opponent’s products. It is argued that the website in **Exhibit GHS1** details no goods and the brochure in the same exhibit demonstrates no evidence of association with the Opponent, nor a date of publication. The same point is highlighted about **Exhibit GHS2** as I highlighted earlier in that the mark identified

is SOFTCARE not SOF.CARE and that there is no indication that it was authorized by the Opponent. The criticism about the lack of connection with the Opponent is also made against the invoices in **Exhibit GHS3** and it is also highlighted that two of the invoices (the ones not listed above because they are not within the relevant proof of use periods) carry the words SOFCARE and SOF CARE PLUS, not SOF.CARE.

Third Witness Statement of Gillian Smaggasgale

13) In reply, a further statement of Ms Smaggasgale of 29 February 2012 (“Third Witness Statement”) contains various exhibits as follows:

- **Exhibit GHS4** – This consists of a copy of a distributorship agreement whereby Gaymar Industries, Inc. appointed Scan Mobility as its exclusive distributor in England, Scotland and Wales. The precise date of signature is not entirely legible on the copy but the year 2007 is clear. It relates to the Plexus and Gaymar range of air pressurized mattresses and accessories. The only reference to SOF.CARE in this document is in the warranty section where there is a reference to Sof.Care Plus bed cushions.
- **Exhibit GHS5** – This contains figures of sales to Scan Mobility which Ms Smaggasgale states relate to products marked SOF.CARE. They consist of a listing of invoices from 2007 amounting in total to the sum of \$30,887.08 and two invoices from 2008 amounting to the sum of \$2,421. The Opponent’s mark is not carried upon them.
- **Exhibit GHS6** – This comprises a UK Medical Devices Agency evaluation of static mattress overlays, which includes a reference to a mattress under the Opponent’s Mark; however, this document, dated October 1994, predates the relevant proof of use periods.
- **Exhibit GHS7** – This contains two invoices from Scan Mobility to two of its UK customers. They are dated 2004 and 2005 respectively which predates the relevant proof of use periods. The goods include Sof.Care cushions, heel care cushions and heel boots.

14) Exhibit **GHS8** shows “*extracts of picking lists for orders places seen Mobility Limited*” [sic]. The first is dated 29 November 1995 (before the relevant periods) to Athodax Surgical in Hertfordshire. It contains a reference to SOF.CARE PLUS BED CU. The second is dated 27 March 2002 (before the relevant periods) to Scan Mobility. It contains a reference to SOF CARE PLUS BED CU and SOF CARE CUSHION. The next two documents are screen shots from a database. Scan Mobility are identified as the customer. They are dated May and April 2010 (within the relevant periods). SOF.CARE is not used, but they include the

product description AIR HEELCARE BOOT and the product code HCB2001, as listed in Scan Mobility Ltd's online brochure in **Exhibit GHS1**.

The proof of use provisions

15) As stated earlier, the proof of use provisions apply to the Opponent's Mark. The use conditions are set out in section 6A(3) of the Act as follows:

"...The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use."

16) Section 100 is also relevant; it reads:

"If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

17) When considering whether genuine use has been shown, I bear in mind the leading authorities on the principles to be applied namely: the judgments of the Court of Justice of the European Union ("CJEU") in *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 ("*Ansul*") and *Laboratoire de la Mer Trade Marks C-259/02* ("*La Mer*"). The position¹ was helpfully summarized by Ms Anna Carboni, sitting as the Appointed Person, in BL O-371-09 *SANT AMBROEUS*:

"42. The hearing officer set out most of the key extracts from *Ansul* and *La Mer* in his decision, so I shall not reproduce them here. Instead, I try to summarise the "legal learning" that flows from them, adding in references to *Silberquelle* where relevant:

(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely "token", which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

¹ Which also took into account the guidance set out in *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

18) The relevant periods for my assessment are the respective five year periods ending on the dates of publication of the Applicant’s marks, namely: 3 July 2005 to 2 July 2010 and 19 February 2006 to 18 February 2011. The Opponent is required to prove that during these periods, and in relation to the relevant goods, there was genuine use by it, or with its consent, of its mark.

19) It is necessary to differentiate between the sales made to Scan Mobility and the use made by Scan Mobility. This is due, not least, to determining whether the

use is with the Opponent's consent. I will deal firstly with the sales to Scan Mobility and its relationship with Gaymar Industries, Inc ("Gaymar Inc"). It is clear that Gaymar Inc have sold products to Scan Mobility – this is evidenced by the material in Exhibits **GHS3**, **GHS5** and **GHS8**. The distribution agreement in Exhibit **GHS4** supports the explanation of events given by Ms Smaggasgale whereby Scan Mobility is appointed as exclusive distributor in England, Wales and Scotland of Gaymar Inc's products. The agreement seems loosely drafted: the SOF.CARE mark is not explicitly mentioned in the definition of products covered; however, references to "Sof.Care Plus Bed Cushion" in the warranty section indicate that some SOF.CARE goods are part of the deal. The totality of the evidence also supports that SOF.CARE goods are part and parcel of the agreement. On the basis of the evidence, I am satisfied that Scan Mobility were the UK distributors for the SOF.CARE goods supplied by Gaymar, Inc. Consent may be inferred from the facts presented in the case². It is Ms Smaggasgale's evidence that the Opponent was part of the same group of companies. Although this would have been better explained by someone in the company, I am prepared to accept, when all the evidence is considered, that the use by Scan Mobility is use with the consent of the Opponent. It therefore follows that Gaymar Inc's sales to Scan Mobility, and also Scan Mobility's use in the UK, if such use constitutes genuine use, is use with the Opponent's consent.

20) That leads to the consideration of the significance of the sales from Gaymar Inc to Scan Mobility. The sales are the output of a distribution agreement, with goods being imported into the UK. However, this does not mean that they cannot constitute genuine use. In *Laboratoires Goëmar SA v La Mer Technology Inc* the Court of Appeal stated:

“Internal use

24. Internal use by the registered proprietor does not count as genuine use. Mr Mellor contended that the use relied on by Goëmar was akin to internal use. I am unable to agree. The sales by Goëmar to Health Scope Direct and the importation of the products into the United Kingdom were events external to Goëmar. There was no suggestion in the evidence that the transactions were otherwise than at arm's length. Although the quantities involved were modest and although there was no evidence of sales on by the importer to consumers and end-users, that does not mean that the use of the mark in the United Kingdom was internal or akin to internal use by Goëmar. The result of the sales was that goods bearing the mark were in different ownership in different hands in another country.

Use by single Importer

25. The question of the use of the mark by an importation by a single importer into a Member State was specifically raised in the reference, as it was a

² See *Einstein Trade Mark*, [2007] RPC 23

special feature of the facts in this case. The answer given in paragraph 24 of the reasoned order was that such use "can be sufficient to demonstrate that such use is genuine." The act of importation of goods can constitute putting the goods bearing the mark on the market in the country to which they are imported. The crucial question is what type or kind of market use is in fact sufficient in the particular case. I now turn to the question of use of the mark on the market for the goods bearing the mark. This is the narrow, but critical, difference between the parties."

and

"33. Trade marks are not only used on the market in which goods bearing the mark are sold to consumers and end users. A market exists in which goods bearing the mark are sold by foreign manufacturers to importers in the United Kingdom. The goods bearing the **La Mer** mark were sold by Goëmar and bought by Health Scope Direct on that market in arm's length transactions. The modest amount of the quantities involved and the more restricted nature of the import market did not prevent the use of the mark on the goods from being genuine use on the market. The Court of Justice made it clear that, provided the use was neither token nor internal, imports by a single importer could suffice for determining whether there was genuine use of the mark on the market.

34. There was some discussion at the hearing about the extent to which Goëmar was entitled to rely on its intention, purpose or motivation in the sales of the goods bearing the mark to Health Scope Direct. I do not find such factors of much assistance in deciding whether there has been genuine use. I do not understand the Court of Justice to hold that subjective factors of that kind are relevant to genuine use. What matters are the objective circumstances in which the goods bearing the mark came to be in the United Kingdom. The presence of the goods was explained, as Dr Trott found, by the UK importer buying and the French manufacturer selling quantities of the goods bearing the mark. The buying and selling of goods involving a foreign manufacturer and a UK importer is evidence of the existence of an economic market of some description for the goods delivered to the importer. The mark registered for the goods was used on *that* market. That was sufficient use for it to be genuine use on the market and in *that* market the mark was being used in accordance with its essential function. The use was real, though modest, and did not cease to be real and genuine because the extinction of the importer as the single customer in the United Kingdom prevented the onward sale of the goods into, and the use of the mark further down, the supply chain in the retail market, in which the mark would come to the attention of consumers and end users."

Thus, the sales from Gaymar Inc. to Scan Mobility can constitute genuine use. Although the evidence is only modest, I am satisfied that it demonstrates a genuine attempt to create and maintain a market share during the use periods.

21) On top of this, there is use by Scan Mobility. Scan Mobility had purchased goods (from Gaymar, Inc) in order to distribute them in the UK. I bear in mind that the only evidence of actual sales by Scan Mobility to the end consumer/user does not fall within the relevant periods. However, it would be counterintuitive to believe that it had purchased goods for UK distribution but did nothing with them. In any event, there is evidence that, at the very least, the availability of the goods was publicised by way of its website in 2009 where Sof.Care accessories were promoted and a brochure was available to download. Taking all of the evidence into account, I am satisfied that, all other things being equal, there has been genuine use of the mark in the relevant periods. I say "all other things being equal" because there are two other issues that I need to address, namely, the form of the mark so used, and the goods concerned. I will deal with the form of the mark first.

Acceptable variant use of the Opponent's mark

22) The brochure on the Scan Mobility website shows use of the mark differing slightly from the Opponent's Mark as registered, in that the full stop between SOF and CARE in the registered mark is shifted upwards to the middle of the line, as follows:

Sof•Care

23) Under section 6A(4)(a) of the Act use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered. Guidance on the test to be applied was provided in the decision of Mr Richard Arnold QC (sitting as the Appointed Person) in *Nirvana Trade Mark* - BL O/262/06:

"The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

24) In this case I consider that the distinctive character of the mark lies in combining the invented word SOF with CARE, the punctuation adding little. I do not think that the average consumer will notice that the full stop which appears in the mark as registered is shifted to the middle of the line. The distinctive

character of the mark is not altered. Consequently, I accept that use of this variant mark contributes to demonstrating genuine use of the mark as registered.

Fair specification

25) Having found that there has been genuine use, I must now consider what would be a fair specification for the goods for which genuine use has been shown. The specification must not be pernickety. It is necessary to consider how the relevant public are likely to describe the goods³. The General Court (“GC”) in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-126/03 held:

“43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered

³ See *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32.

unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of „part of the goods or services’ cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category.”

26) I also note the comments of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10, where he stated:

“However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods concerned”

27) The Opponent’s Mark is registered in respect of:

Class 10: Surgical, medical and therapy apparatus and instruments; upholstery for surgical, medical and therapeutic purposes; contoured and inflated cushions for patients’ use on beds and chairs; parts and fittings for all the aforesaid goods; all included in Class 10.

The invoices submitted show several consignments of the “Heelboot” (HCB2001) and one consignment (100 items) of the Heel Pad (HC200CE) to the Opponent’s UK distributor, Scan Mobility Ltd, within the proof of use periods. On the evidence of Scan Mobility Ltd’s online catalogue, these were offered for sale in the UK, along with seat cushions and theatre pads, under the Opponent’s Mark within the relevant periods.

28) The general category “*surgical, medical and therapy apparatus and instruments*” is clearly far too broad a category to describe these goods. On the other hand, I think the specifications “*upholstery for surgical, medical and therapeutic purposes*” and “*contoured and inflated cushions for patients’ use on beds and chairs*” would, on their own, be too pernickety and more should be allowed to represent fairly the type of use shown. Bearing this in mind, and having regard to the purpose and use of the products and the perceptions of the average consumer, I consider that the following would be a fair specification:

Class 10: Pressure-relieving devices adapted for surgical, medical or nursing purposes; parts and fittings for the aforesaid goods; upholstery for surgical, medical and therapeutic purposes; contoured and inflated cushions for patients’ use on beds and chairs; parts and fittings for all the aforesaid goods; all included in Class 10.

29) For the purposes of the opposition I shall confine my comparison of the goods to this specification.

Section 5(2)(b)

The law

30) Section 5(2)(b) of the Act reads:

“5(2) A trade mark shall not be registered if because –

(a)

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

31) In reaching my decision I have taken into account the guidance provided by the CJEU in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, Case C-3/03 *Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

The Average Consumer

32) According to the case-law, the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods or service providers can, however, vary depending on what is involved (see, for example, the judgment of the GC in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

33) According to Ms Smaggasgale's Second Witness Statement, the Opponent's products are sold primarily into the NHS for use within the community setting, i.e. to Primary Care Trusts. Medical care organisations are, therefore, clearly average consumers. However, I do not rule out that members of the public may also be potential purchasers of the products; they will also be end-users. But whoever purchases the products, they will be organisations or persons concerned with the care of persons for whom pressure relief is required owing to limited mobility, confinement to bed, or the person who is in need of the article. As such, they may be expected to show an above average (although not the highest) level of attention when selecting goods of this type. I have no evidence specifically addressing the nature of the purchasing process. It seems reasonable to assume that for goods of this nature it will be predominantly visual (selection of goods from a catalogue, purchase from specialist sales outlets, etc.), though oral communication may also play some role.

Comparison of the goods

34) In making an assessment of the similarity of the goods, all relevant factors relating to the goods in the respective specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro- Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

"In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

35) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

36) Whether goods are complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), will depend on whether there exists a close connection or relationship such that one is important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06 it was stated:

“It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

37) Finally, when comparing the respective goods, if a term clearly falls within the ambit of a term in the competing specification then identical goods must be considered to be in play (see *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-133/05 (“*Meric*”)) even if there may be other goods within the broader term that are not identical.

38) I will make the comparison with reference to the goods for which registration is sought by the Applicant, comparing them with the specification I have found to be justified by the evidence of use of the Opponent’s Mark, namely:

Class 10: Pressure-relieving devices adapted for surgical, medical or nursing purposes; parts and fittings for the aforesaid goods; upholstery for surgical, medical and therapeutic purposes; contoured and inflated cushions for patients' use on beds and chairs; parts and fittings for all the aforesaid goods; all included in Class 10.

I will go through them term by term, but grouping them when it is useful and reasonable to do so – see the comments of the Appointed Person in *Separode* BL O-399-10.

Class 10: Surgical and medical apparatus and instruments

39) The Opponent's Mark covers *pressure-relieving devices adapted for surgical, medical or nursing purposes*. This falls within the ambit of the above. Applying the guidance in *Meric*, I find that the goods are, therefore, identical, although, I accept that there may be other goods within the applied for term which are not identical, or, indeed, may not even be similar; I will come back to this point later if need be.

Class 10: Cushions for prevention of bed sores

40) The above falls within the ambit of *pressure-relieving devices adapted for surgical, medical or nursing purposes* covered by the Opponent's Mark. The goods are therefore identical.

Class 10: Mattresses for medical purposes; foam mattresses for medical purposes; cushions for medical purposes; positioning cushions for the physically handicapped, those of reduced mobility and invalids;

41) Cushions and mattresses of the above descriptions have a potentially close competitive medical function in terms of pressure relief. Such goods are at least highly similar to *pressure-relieving devices adapted for surgical, medical or nursing purposes*. Those designed specifically for pressure relief are identical.

Class 10: Beds for medical purposes; waterbeds for medical purposes; airbeds for medical purposes;

42) Beds clearly serve a broader purpose than the specific medical cushioning functions performed by the items discussed in paragraph 39, and I do not consider that they will be regarded by the relevant public as competing directly with those products. Nevertheless, beds of the above descriptions may also perform functions of pressure relief. They are specifically designed for the purposes of medical or nursing care. Their users will thus be largely the same as those for products of the Opponent's specification, there may be a degree of complementarity in their use, and they may share the same channels of trade.

There is a reasonable degree of similarity with *pressure-relieving devices adapted for surgical, medical or nursing purposes*.

Class 10: Adjustable backrests for beds for medical purposes; bedclothes frames for the physically handicapped;

43) The primary function of bedclothes frames is to relieve vulnerable patients from the weight of bedclothes. Backrests serve to adjust the posture of the patient in bed. Both these items, together with pressure-relieving devices, may play an important complementary role in addressing the specific medical and nursing needs of a particular group of users (e.g. persons confined to bed whose specific condition requires control of posture, weight and bedclothes distribution to avoid concentration of pressure on vulnerable points), so that the relevant public may think that responsibility for them lies with the same undertaking. They will to a large extent share the same channels of trade. There is a reasonable degree of similarity with *pressure-relieving devices adapted for surgical, medical or nursing purposes*.

Class 10: Supporting apparatus, lifting apparatus, transfer apparatus, hoists, slings and spreaders, all for the physically handicapped, those of reduced mobility and invalids; lifting apparatus and transfer apparatus for the bath, the bed and the toilet for the physically handicapped, those of reduced mobility and invalids; security jackets, harnesses and belts for the physically handicapped, those of reduced mobility and invalids; bed lifters, bed rails, all for the physically handicapped, those of reduced mobility and invalids; corsetry for medical purposes; walking aids; crutches, walking frames, rollators; reach extension devices, applicators for socks, stockings and panty hose, all for use by the physically handicapped, those of reduced mobility and invalids; shower stretchers for the physically handicapped, those of reduced mobility and invalids; rehabilitation, training and play equipment for the physically handicapped, those of reduced mobility and invalids; rehabilitation, training and play equipment in the form of elastic seating, elastic chairs, elastic ramps, elastic rollers and elastic tunnels for the physically handicapped, those of reduced mobility and invalids;

Class 12: Vehicles for the physically handicapped and those of reduced mobility; wheelchairs, push wheelchairs, manually propelled wheelchairs, sporting wheelchairs, leisure wheelchairs, powered wheelchairs; electrical propulsion units for wheelchairs; electrical driving equipment for manually propelled wheelchairs; electric motors for vehicles; scooters; powered tricycles and quadricycles for the physically handicapped and those of reduced mobility; shower trolleys for use by the physically handicapped and those of reduced mobility; seating platform for power wheelchairs, in particular for power wheelchairs;

Class 20: Furniture for the physically handicapped, those of reduced mobility and invalids; home care beds, institutional beds, hospital beds; hangers, bed rails, bed tables, baskets, baskets for supporting medical apparatus; bath seats, shower seats and toilet supports; hand rails and bars for toilets, bathrooms, baths and showers; lift-out chairs; work seats for the physically handicapped and those of reduced mobility;

44) As with previous categories, items in these categories are either designed for, or may be suitable for use in, the medical treatment or nursing or general care of persons confined to bed or of limited mobility. To this extent their users may be broadly the same and they may be expected to share to a large extent the same channels of trade. However, I do not consider that goods in these categories will be seen by the relevant public as having the same potential, direct competitive function. There is at best a low degree of similarity with the *pressure-relieving devices adapted for surgical, medical or nursing purposes*.

Class 10: Orthopaedic articles

45) These could, for example, include articles such as orthopaedic cushions; these do not serve precisely the same medical purpose as pressure-relieving cushions, but their uses may overlap and the physical nature of the articles is clearly close. They may be expected to some extent to share the same channels of trade. There is a reasonable degree of similarity between such goods (although I accept that there may be other goods within the applied for term which do not have this degree of similarity; I will come back to this point later if need be).

Class 10: artificial limbs, eyes and teeth; suture materials; respiratory apparatus; oxygen concentrators, apparatus for the distribution and storing of liquid oxygen, aerosol therapy apparatus, respiratory apparatus for sleep therapy; apparatus for ventilation of the lungs;

46) There is no immediate connection between these goods and those appropriate for the medical and nursing care of persons for whom pressure relief is required. There is no competition between them and pressure-relieving products, and channels of trade may be different. There is no similarity.

Class 20: Furniture; beds and accessories for beds; mattresses; foam mattresses; airbeds and waterbeds; seating, backrests, cushions.

47) These goods in Class 20 will be intended for general use and will not be specifically adapted, or appropriate, for medical or nursing care. The goods will be chosen for comfort and convenience in general use. The average consumer will consist of the public at large (and those catering to the public at large, such as hotels, etc.), and the channels of trade will be those serving these buyers.

There is no similarity with *pressure-relieving devices adapted for surgical, medical or nursing purposes*.

48) The Applicant seeks protection for *parts and fittings* for all the goods for which it seeks registration, and I have included *parts and fittings* for all the goods in the specification I have found justified by evidence of use of the Opponent's mark. I consider that the applied for parts and fittings succeed and fail to the same extent as the primary goods.

Distinctiveness of the earlier mark

49) The degree of distinctiveness of the Opponent's Mark must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). Even taking into account evidence relating to periods before and after the relevant periods of use, the evidence falls well short of establishing that the Opponent's Mark is entitled to an enhanced degree of distinctiveness. In terms of the mark's inherent characteristics, the word CARE lacks distinctive character in relation to goods within the specification for the Opponent's Mark – i.e. products used in medical or nursing care. However, the made-up word SOF lends the mark as a whole a reasonable degree of distinctiveness.

Comparison of the Marks

50) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are:

The Applicant's Marks	The Opponent's Mark
SOFT-AIR	SOF.CARE

51) The Applicant's Marks consist of two common English words, joined by a hyphen. However, SOFT qualifies AIR, with neither word component dominating the other. The word CARE in the Opponent's Mark lacks distinctive character in relation to goods involving medical or nursing care. It is the made-up word SOF which is the dominant element, although I must still bear in mind that it is a whole mark comparison.

52) Visually, both marks consist of seven letters, the first three of which are identical. All are broken roughly in the middle by a punctuation mark. I do not consider that the punctuation plays a very significant role; it simply confirms the

natural division of the marks visually into their short, easily registered components, though I think the marks will be perceived as wholes. The rule of thumb is that a consumer normally attaches more importance to the first part of a word. The first three letters of the marks being the same, there is clearly some similarity between SOF and SOFT. However, the T makes a visually noticeable difference to these initial short components. There is no real similarity between the words AIR and CARE. They are different in length and begin and end with different letters. The degree of visual similarity between the marks viewed as a whole is low.

53) From an aural perspective, all the marks consist of a word of two syllables, beginning with the same consonant, containing the same vowel sounds in the same sequence, and ending with the same sound. However, the difference in articulation between the T in SOFT-AIR and the C in SOF.CARE results in a distinctively different consonant break. The Opponent suggests that the T in SOFT-AIR is likely to be given little weight and “swallowed” in oral use. Whilst this is noted, I do not agree that this is likely to be the norm. Furthermore, the C (in SOF.CARE) would remain clearly aurally distinctive. There is a reasonable but not high degree of aural similarity between the marks.

54) SOF, being an invented word, has no conceptual meaning. The words SOFT and AIR in the Applicant’s Marks are suggestive of physical qualities of softness and lightness of air, whereas the word CARE evokes abstract notions of attention and treatment. There is thus some conceptual dissimilarity between the marks.

Likelihood of confusion

55) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

56) I have found varying degrees of similarity between the goods specified in the application and those covered by the Opponent’s Mark, ranging from identical to no similarity. I have found that the Opponent’s Mark is not entitled to an enhanced degree of distinctiveness through use, but that it has a reasonable degree of inherent distinctiveness. I have found the marks to have a low degree of visual similarity, a reasonable but not high degree of aural similarity, and to be conceptually dissimilar.

57) Bearing all this in mind, together with my assessment of the nature of the average consumer and their purchasing process, and having regard to the

interdependency principle, I do not consider that there is a likelihood that the average consumer will be confused. This is so even bearing in mind the concept of imperfect recollection, and that a low degree of similarity between the marks may be offset by a high degree of similarity between the goods, some of the goods in this case being identical.

58) In coming to my view on this matter, I have not ignored my reference in paragraph 10 regarding two invoices on which SOFTCARE was written rather than SOF.CARE. Whilst there is nothing significant in terms of the missing full stop, it could be argued that SOF being written as SOFT is indicative that SOF is being read (or heard) as SOFT and, that this points towards confusion with SOFT AIR. However, I have no evidence on the background to how the mark came to be written as SOFTCARE, such as who wrote it and what they encountered; in view of this, I place no real weight on this point; it does not alter my assessment of the likelihood of confusion. The marks will be perceived as wholes. The differences in the marks overall are sufficient for the average consumer to differentiate between them even when identical goods are considered. Accordingly, there is no likelihood of confusion in respect of any of the goods. **The opposition fails in its entirety.**

Costs

59) The opposition having failed, Invacare International Sarl is the successful party and is entitled to a contribution towards its costs. I hereby order Medisearch PR, Inc to pay Invacare International Sarl the sum of £1,000. This sum is calculated as follows:

Considering the statements submitted by Medisearch PR, Inc and preparing counterstatements – £400

Considering and commenting on evidence submitted by Medisearch PR, Inc – £600.

60) The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

Dated 1st of August 2012

**Martin Boyle
For the Registrar,
The Comptroller-General**